

## **REMARKS**

### **STATUS OF CLAIMS**

Claims 12-27 are now pending in this application. No new matter has been added.

### **REJECTION OF CLAIMS UNDER 35 U.S.C. § 102 AND § 103**

Claims 12-27 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Fertilsch (US 2004/0061890).

The rejections are respectfully traversed.

The present invention is characterized by an image processing apparatus for storing plural file formats which permit (or prohibit) addition of an image processing command to read image data in a storage unit, determining a file format into which the read image data will be converted, judging whether the file format thus determined is stored in the storage unit, and when judging that the file format thus determined is stored in the storage unit, permitting (or prohibiting) addition of the image processing command to the read image data.

The Examiner relies on Fertilsch to establish anticipation of claims 12-27 of the present application. However, Applicant does not believe that Fertilsch anticipates claim 12-27. Fertilsch discloses a technology for effectively selecting an appropriate printer from plural printers having many kinds of different print capabilities, when performing a print job designated from a client terminal, which is substantially different from the image processing system disclosed in the present application.

When the claims of the present application are compared with Fertilsch, the distinct differences described below in detail are found.

(a) In the present invention, read image data is converted into a file format which is determined from among plural file formats (see independent claims 12, 13, 24, 26 and 27). However, Fertilsch fails to specifically disclose such conversion into a file format. While the Examiner explains specific portions of Fertilsch in detail regarding the feature “addition of the image processing command to the read image data” of the present invention, the Examiner, however, fails to cite any portion of Fertilsch that relates to this “conversion into a file format”.

(b) Fertilsch fails to disclose or suggest the “storage unit for storing file formats which permit (or prohibit) addition of an image processing command to read image data” (see independent claims 12, 13, 24, 26 and 27). The Examiner refers to the “mass storage device 28” of Fertilsch as a component corresponding to the “storage unit” of the present invention, However, in Fertilsch, there is no description of “storing file formats” in “mass storage device 28”.

(c) Fertilsch fails to disclose or suggest the “judging unit which judges whether the file format thus determined is stored in the storage unit” or “making said controller judge whether the file format thus determined is stored in said storage unit” of the present invention (see independent claims 12, 13, 24, 26 and 27). The Examiner refers to the “print processor 49” of Fertilsch as a component corresponding to this “judging unit” or step of “making said controller judge” of the present invention. However, the “print processor 49” only judges which printer is matched with a designated print job, and therefore, performs a judging processing that is totally different from the present invention.

(d) Fertilsch fails to disclose or suggest “when judging that the file format thus determined is stored in the storage unit, prohibiting (or permitting) addition of an image processing command to the read image data” (see independent claims 12, 13, 24, 26 and 27). The Examiner refers to paragraph [00131] of Fertilsch with regard to this feature. In this regard, the Examiner considers that adding optional capabilities to a print job is same as the above-mentioned feature of the present invention. However, such extreme generalization of what is disclosed in Fertilsch still does not establish that Fertilsch actually discloses this specific feature.

Dependent claims 15, 19 and 23 delineate a determining unit which determines, *in accordance with a load condition*, whether to add the image processing command to the read image data. The Examiner maintains this is disclosed at paragraph [0028] of Fertilsch. Paragraph [0028] describes:

[0028] Embodiments of the present invention embrace a computer device that may be used in a printing environment. In one embodiment, a printing environment includes a system comprising one or more print drivers, a print processor, two or more printing devices and optionally one or more print servers. Capabilities needed to process a print job are matched with the capabilities of the printing devices that are available in the system. In a further embodiment, a print processor is used in performing the capabilities matching.

There clearly is no description in paragraph [0028] regarding determining whether to add the image processing command to the read image data *in accordance with a load condition* of the image processing apparatus.

Dependent claim 20 delineates that the sending unit sends an electronic mail to which the image data converted into the file format thus determined is attached. The Examiner maintains this is disclosed at paragraph [0057] of Fertilsch. Paragraph [0057] describes:

[0057] Upon initiation of the print job, the user selects a command or sequence of commands or stimulus to indicate an intention to spool a print job. The computer device responds to the user by presenting the user a dialog (e.g., a Printer UI, command line query, front panel display, etc.) in which the user may select options relating to the spooling of the print job. This is illustrated in FIG. 5 as step 120, where the dialog is provided. One of the options available in the dialog is the selection of the printing device(s) (e.g., printer, plotter, MFP, CD burner, etc.) to which the print job is despoiled. At step 122, input is received that corresponds to the options that are available on the dialogue.

There clearly is no description in paragraph [0057] regarding e-mail (electronic mail) being sent by a sending unit with the image data converted into the determined file format attached to the e-mail.

A claim is anticipated only if each and every element/step as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Since each an every element/step of independent claims 12-27 is not found in Fertilsch, the reference does not anticipate claims 12-27 and their allowance is respectfully solicited.

## **CONCLUSION**

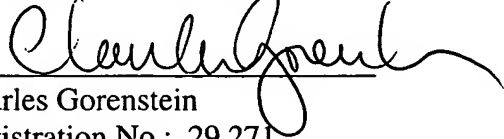
In view of the above, applicant(s) believes the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Edward J. Wise (Reg. No. 34,523) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: October 10, 2008

Respectfully submitted,

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